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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/754,756	01/04/2001	Marshall Wayne Thomas	13DV13543	3774

31852 7590 01/04/2005

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EXAMINER

GARCIA OTERO, EDUARDO

ART UNIT	PAPER NUMBER
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2123

DATE MAILED: 01/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application N .	Applicant(s)	
	09/754,756	THOMAS, MARSHALL WAYNE	
	Examiner	Art Unit	
	Eduardo Garcia-Otero	2123	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION-Final Action

Introduction

1. Title is: EXCEEDANCE PROTECTION PROCESS.
2. Inventor is: THOMAS.
3. US Application filed 1/4/2001, no earlier priority is claimed.
4. Applicant's Amendment was received 10/4/04.
5. Claims 1-18 are pending.

List of Important Prior Art

6. Enokido refers to US Patent 6,243,835.
7. Mitchell refers to US Patent 6,323,774.

Applicant's Remarks

8. 35 USC 101. PHYSICAL PROCESS STEPS. Remarks page 8. Applicant asserts that independent claims 1 and 10 contain "physical process steps" per *Arrhythmia Research Technology, Inc. v. Corazonix Corp.*, 958 F.2d 1053, 1058, 22 USPQ2d 1033, 1037 (Fed. Cir. 1992).
9. Remarks page 9. Specifically, Applicant asserts that *Arrhythmia* found that "converting", "applying", "determining", and "comparing" are physical process steps, and not merely data gathering steps. This appears to be a somewhat incomplete discussion and somewhat inaccurate interpretation of *Arrhythmia*. In the context of the facts of the case, *Arrhythmia* page 1038 states "These claimed steps of "converting", "applying", "determining", and "comparing" are **physical process steps that transform one physical, electrical signal into another.**" Emphasis added.
10. To summarize the facts of *Arrhythmia*, analog electrical signals are converted into digital electrical signals, the digital signals are modified and analyzed, and the resultant output indicates the patient's risk for ventricular tachycardia. The patient's risk is then used for medical diagnosis and/or treatment.
11. In contrast to the facts of *Arrhythmia*, the present claims do not convert analog signals into digital signals. Thus, the words "converting", "applying", "determining", and "comparing" do not automatically create a statutory process, but rather must be considered in the context of the facts.

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12. Additionally, the claim 1 terms “generate an output” and “generate a design output” are so tenuous that they do not satisfy 35 USC 101. Note *In re Sarker*, 200 USPQ 132, (CCPA), Dec. 7 1978 at page 137 discusses the significance of “post-solution activity” like building a bridge or a dam, and states “While it is true that the final step in each of these claims makes reference to the mathematical result achieved by performing the prior recited steps, we consider the connection to be so tenuous that the several steps recited in each claim when considered as a whole do not constitute a proper method under the statute”.
13. Thus, Applicant’s assertions are not persuasive.
14. **However, the claim 1 limitation “issuing an alert indicative of whether the comparison identifies and exceedance of the limits” is a useful, concrete, and tangible output, and thus satisfies 35 USC 101. The prior 35 USC 101 rejections are withdrawn.**
15. 35 USC 112 WRITTEN DESCRIPTION. Remarks page 9. The prior 35 USC 112 rejections are withdrawn due to Applicant’s amendments. However, new 35 USC 112 rejections are presented below.
16. PRIOR ART REJECTIONS. Remarks page 8. Applicant asserts that the Enokido patent is limited to production process, and is not applicable to the design process of the present claims. Specifically, Applicant asserts “the design process is when a computer-aided software engineering tool is utilized”.
17. First, claim 1 does not include the limitation “computer-aided software design”.
Additionally, note that Enokido Column 1 line 39 states “A typical known testing tool of this kind, for instance, is “SQA suite (registered trademark of SQA Inc. in the United States)”. This tool manages a whole sequence of software testing processes from test planning/design to generation of a report on test results.”
18. Second, the claim 1 preamble states “method for conforming a design with existing design requirements”. This broad statement appears applicable to either initial design, or to production. Third, the Enokido testing process appears applicable to design or to production.
19. Fourth, claim 1 uses the term “design output” in one of the limitations, and this term has been rejected as indefinite. See below.
20. Thus, Applicant’s assertions are not persuasive, and the 35 USC 102 rejections are maintained.

35 USC § 112-Second Paragraph-indefinite claims

21. The following is a quotation of the second paragraph of 35 U.S.C. 112: The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
22. Claims 1-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
23. In claim 1 (currently amended), the term “calculation means” is not clearly defined in the specification.
24. Also in claim 1 (currently amended), the term “comparing the output to the limits to generate a design output” is not clear. Specifically, in the context of the specification, the term “comparing” appears to be a determination of whether the output satisfies design constraints (“limits”). However, it is not clear how this comparison generates a design output. Note that the following limitation discusses an “alert”.
25. Claims 2-18 are indefinite for the same reasons.

Claim Rejections - 35 USC § 102(e)

26. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action: A person shall be entitled to a patent unless – (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.
27. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).
28. Claims 1-18 are rejected under 35 U.S.C. 102(e)
29. Claim 1 (currently amended) is rejected under 35 U.S.C. 102(e) as being anticipated by Enokido et al. US Patent 6,243,835 B1.
30. Claim 1 is an independent claim with 5 limitations.
31. **“limits into an input file”** is disclosed by Enokido at FIG 1 element 9 “DESIGN TABLES”.

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32. **“input file into a calculation means”** is disclosed by Enokido at FIG 1 element 2 “DESIGN INFORMATION READING MEANS”.
33. **“calculation means to generate an output”** is disclosed by Enokido at FIG 1 element 4 “DATA ANALYSIS MEANS”. Additionally, note that Enokido Column 1 line 39 states “A typical known testing tool of this kind, for instance, is “SQA suite (registered trademark of SQA Inc. in the United States)”. This tool manages a whole sequence of software testing processes from test planning/design to generation of a report on test results.”
34. **“compare the output to the limits to generate a design output”** is disclosed by Enokido at FIG 1 element 6 “FIRST TEST ITEM GENERATION MEANS”.
35. **“issue an alert”** is disclosed by Enokido at FIG 1 element 8 “TEST SPECIFICATION WRITING MEANS”.
36. Additionally, note that Enokido Column 1 line 39 states “A typical known testing tool of this kind, for instance, is “SQA suite (registered trademark of SQA Inc. in the United States)”. This tool manages a whole sequence of software testing processes from test planning/design to generation of a report on test results.”
37. **ALTERNATE REJECTION: Claim 1 is alternately rejected under 35 U.S.C. 102(e)** as being anticipated by Mitchell US Patent 6,323,774 B1, which will be referred to as Mitchell. Claim 1 is an independent claim with 5 limitations.
38. **“limits into an input file”** is disclosed by Mitchell at abstract “processor that includes a program for setting threshold values”
39. **“input file into a calculation means”** is disclosed by Mitchell at abstract ““processor that includes a program for setting threshold values of water volume per unit time anticipated by the particular household”
40. **“calculations means to generate an output”** is disclosed by Mitchell at abstract “system is programmed in volume increments of time such as hours, days, or weeks to accommodate systems that include sprinklers which may require some volume of water over a short period of time”.
41. **“compare the output to the limits to generate a design output”** is disclosed by Mitchell at abstract “the threshold value of the system could be preprogrammed...which if exceeded would set off the alarm”.

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42. **“issue an alert”** is disclosed by Mitchell at abstract “set off the alarm”.
43. Claim 2 is rejected under 35 U.S.C. 102(e) as being anticipated by Enokido. Claim 2 depends from Claim 1 with one additional limitation.
44. **“limits comprise specified quantifiable limits”** is inherently disclosed by Enokido at FIG 1 element 9 “DESIGN TABLES”, and alternately disclosed by FIG 1 element 6 “FIRST TEST ITEM GENERATION MEANS”.
45. Claim 3 is rejected under 35 U.S.C. 102(e) as being anticipated by Enokido. Claim 3 depends from Claim 1 with one additional limitation.
46. **“web based tool to electronically read the limits”** is disclosed by Enokido at FIG 1 element 2 “DESIGN INFORMATION READING MEANS”.
47. Claim 4 is rejected under 35 U.S.C. 102(e) as being anticipated by Enokido. Claim 4 depends from Claim 1 with one additional limitation.
48. **“creating a sub-routine to automatically compare the analyses output with the limits”** is disclosed by FIG 1 element 6 “FIRST TEST ITEM GENERATION MEANS”.
49. Claim 5 is rejected under 35 U.S.C. 102(e) as being anticipated by Enokido. Claim 5 depends from Claim 4 with one additional limitation.
50. **“analyses output comprises engineering calculations relevant to the design”** is disclosed by Enokido at FIG 1 element 6 “FIRST TEST ITEM GENERATION MEANS”.
51. Claim 6 is rejected under 35 U.S.C. 102(e) as being anticipated by Enokido. Claim 6 depends from Claim 5 with one additional limitation.
52. **“applying an exceedance detection algorithm”** is disclosed by Enokido at FIG 1 element 6 “FIRST TEST ITEM GENERATION MEANS”.
53. Claim 7 is rejected under 35 U.S.C. 102(e) as being anticipated by Enokido. Claim 7 depends from Claim 6 with one additional limitation.
54. **“indicates if an exceedance of a computer model engineering calculation is greater than the limits”** is disclosed by Enokido at FIG 1 element 8 “TEST SPECIFICATION WRITING MEANS”.
55. Claim 8 is rejected under 35 U.S.C. 102(e) as being anticipated by Enokido. Claim 8 depends from Claim 1 with one additional limitation.

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56. **“issuing an alert message to a user”** is disclosed by Enokido at FIG 1 element 8 **“TEST SPECIFICATION WRITING MEANS”**.
57. Claim 9 is rejected under 35 U.S.C. 102(e) as being anticipated by Enokido. Claim 9 depends from Claim 1 with one additional limitation.
58. **“outputting engineering specifications and performance results of the design”** is disclosed by Enokido at FIG 1 element 8 **“TEST SPECIFICATION WRITING MEANS”**.
59. Claims 10-18 are “system” type claims with the same limitations as “method” claims 1-9, and are rejected for the same reasons.

Conclusion

60. All pending claims are rejected under 35 USC 112 and 35 USC 102.

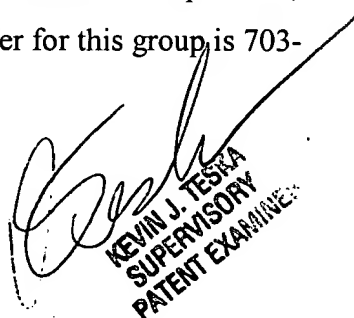
Response to Amendments or new IDS-FINAL OFFICE ACTION

61. Applicant's amendments or new IDS necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Communication

62. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eduardo Garcia-Otero whose telephone number is 571-272-3711. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 8:00 PM. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Kevin Teska, can be reached at 571-272-3761. The fax phone number for this group is 703-872-9306.

* * * *


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SUPERVISORY
PATENT EXAMINER